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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,016	11/24/1999	YAKOV KAMEN	ISURFTV11	5713

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EXAMINER

BUI, KIEU OANH T

ART UNIT

PAPER NUMBER

2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/449,016

Applicant(s)

KAMEN ET AL.

Examiner

KIEU-OANH BUI

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2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-14, 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/10/06 has been entered.

### ***Remark***

2. Claims 17-48 are withdrawn; claims 2 and 15 have been canceled, and claims 1, 3-14, and 16 are pending for reconsideration. Claims 17-48 should be cancelled in subsequent response.

### ***Specification***

3. The abstract of the disclosure is objected to because the term "For example" should be removed from the abstract. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1, 3-14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Reynolds et al. (U.S. Patent No. 6,934,963 B1).

Regarding claim 1, Reynolds teaches this exact same technique as Reynolds shows as in Figure 15, while viewing a current video for a current channel, a user can select a second window screen with a second television program segment for displaying to the user, and as soon as the user selects the second television program segment, modify or change the displaying of the window region of the first program to the second program accordingly (col. 19/lines 27-67 as the user selects one of the displaying program segment and hit OK to watch, the second program segment is displaying to the user).

(Claim 2 has been cancelled).

As for claim 3, Reynolds teaches the window region is a banner advertising products and/or services (Fig. 15 and/or Figs. 9a-9b with banner 910 for a video per-pay-view promotion).

As for claim 4, Reynolds further teaches to include the thumbnail commercial as shown in Fig. 10 while the user views some information about the video promotional, some additional thumbnails in "selectable advertisement" are displaying.

As for claims 5-6 and 14, Reynolds teaches the segment is a commercial and the banner indicative of a product being advertised during the commercial (refer back again to Figs. 9a & 9b, and col. 16/line 47 to col. 17/line 10).

As for claims 7, 9-10 and 16, Reynolds further teaches the availability and accessing to the Internet from the video screen as well as the link and link to a web page (refer to Figs. 2c, 2d, 8b, and col. 10/line 46 to col. 11/line 20; and col. 16/lines 23-46).

As for claim 8, Reynolds further teaches to change to another regularly television channel on the video screen (Fig. 16 and col. 21/lines 20-58 as the user can select which sources or servers, i.e., television channels and/or from the internet, and interactively sets and selects any program segment to display).

For claim 11, Reynolds teaches an exact same method as cited, refer back to claim 1 above, and the user can select by clicking on the banner, i.e., another term, "selectable banner" (refer back again to Figs. 9a, 9b, 10 & 15).

As for claim 12, Reynolds further teaches the additional signal information to be displayed is included in a portion of a video signal that does not normally contain visual information (Fig. 15, the selectable banner 972 -for 15 GDE and 101 CNN- does not contain visual information but text information).

As for claim 13, Reynolds further teaches wherein the portion of the video signal comprises a retrace interval or a blanking interval (col. 9/lines 12-25).

(Claim 15 has been cancelled).

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### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Knowles et al., and Gagnon et al (PTO-892 attached) teaches systems related to interactive television electronic program guide with similar approaches on changing program segments and advertisement banners.

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7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to PTO New Central Fax number:**

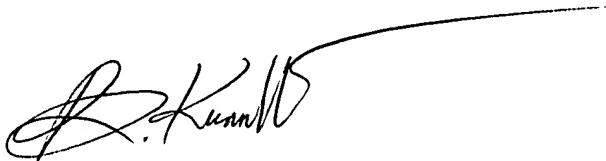
(571) 273-8300, (for Technology Center 2600 only)

Hand deliveries must be made to Customer Service Window,  
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to "Krista" Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller, can be reached at (571) 272-7353.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'K. Bui', with a long horizontal line extending to the right.

Kieu-Oanh Bui  
Primary Examiner  
Art Unit 2623

KB

December 18, 2006